

ESTTA Tracking number: **ESTTA111323**

Filing date: **11/24/2006**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	BrandStorm Inc.		
Entity	Corporation	Citizenship	California
Address	10853 Venice Blvd. Suite 2 Los Angeles, CA 90034 UNITED STATES		

Attorney information	John Arai Mitchell Arai Mitchell pc 453 South Spring Street Suite 930 Los Angeles, CA 90013 UNITED STATES mitch@araimitchell.com, heidi@araimitchell.com Phone:213-622-2324
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Applicant Information

Application No	78857705	Publication date	10/24/2006
Opposition Filing Date	11/24/2006	Opposition Period Ends	11/23/2006
Applicant	FREELIFE INTERNATIONAL, LLC 333 Quarry Road Milford, CT 06460 UNITED STATES		

Goods/Services Affected by Opposition

Class 032. All goods and sevicees in the class are opposed, namely: Fruit-based beverages that are also nutritionally fortified and sports drinks
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Attachments	Opposition to 78857705.pdf (5 pages)(5932651 bytes)
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Signature	/j. a. mitchell/
Name	John Arai Mitchell
Date	11/24/2006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of
Application Serial No. 78857705
For the mark FREELIFE HIMALAYAN
GOJI
Published in the Official Gazette on
October 24, 2006

BRANDSTORM INCORPORATED)	Opposition No. _____
)	
Opposer,)	
)	
v.)	
)	
FREELIFE INTERNATIONAL, LLC)	
)	
Applicant.)	
)	

NOTICE OF OPPOSITION

BrandStorm Inc. ("Opposer"),
a California corporation
10853 Venice Boulevard, Suite 2
Los Angeles, California 90034

The above-identified Opposer believes that it will be damaged by the registration of the mark shown in the above-identified application (the "Application"), and hereby opposes the same.

The grounds for opposition are as follows:

1. Opposer BrandStorm Inc. provides high-quality dried Goji berries under the mark "HIMALANIA".
2. Since at least March 2005, Opposer has sold "HIMALANIA" branded Goji berries in California and interstate commerce.
3. Opposer's "HIMALANIA" branded Goji berries are currently stocked in a number of national retail chains, including Whole Foods, Wild Oats, Vitamin Shoppe and Robek's Juice. Opposer's "HIMALANIA" branded Goji berries are also carried at many regional retailers, including Henry's, Mother's, Sun Harvest, Zabar's, Amish, Grace's

and Garden of Eden. In addition, Opposer's "HIMALANIA" branded Goji berries are available via the Internet at websites such as <www.vitaminshoppe.com>, <www.drugstore.com>, and <www.dr.fuhrman.com>.

4. Opposer's "HIMALANIA" mark has acquired a fine and valuable reputation due to: (a) the care and skill that Opposer exercised in the marketing, sale and rendering of its goods; (b) its supervision and control over the nature and quality of those goods; and (c) the extensive advertising, sale and public acceptance of Opposer's goods. Additionally, Opposer's "HIMALANIA" mark is a strong mark due to its fancifulness.

5. The Trademark Trial and Appeals Board (the "Board") should reject the application for the mark "FREELIFE HIMALAYAN GOJI" because the words "HIMALAYAN GOJI" are purely descriptive. A mark is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the relevant goods. 15 U.S.C. § 1052(e)(1). The term "GOJI" is the common and generic name of a type of berry also known as the wolfberry. Goji berries, or wolfberries, are grown on vines in China, Mongolia and Tibet, where they are also drunk in juice form. BBC News, <http://news.bbc.co.uk/2/hi/uk_news/magazine/5315202.stm> (22 November 2006). The Goji berry is found in the Himalayan region and is an ingredient found in a variety of goods and products, including moisturizers, shampoos, nutritional/dietary supplements and food bars. The term "GOJI" describes exactly the ingredient found in Applicant's nutritional supplements and nutritionally fortified fruit-based beverages. The relevant public perceives the term "GOJI" as descriptive of an ingredient, feature, function, or other element. In this case, customers and potential purchasers would necessarily conclude that Goji was an ingredient of Applicant's products.

6. The Board should reject the application for the mark "FREELIFE HIMALAYAN GOJI" because the word "HIMALAYAN" is primarily geographically descriptive of the origin of Applicant's goods. 15 U.S.C. § 1052(e)(2). The term HIMALAYAN is an adjective describing something or someone originating from or related to a geographic region generally known as a mountain range spanning Tibet, India and China. Customers and potential purchasers will also associate the Applicant's goods with the Himalayas because readily available public literature and information show that

Tibetans use Goji berries for their anti-aging benefits. Accordingly, there is a presumed goods/place association because the public will believe that Applicant's products, which contain Goji berries, come from the Himalayan region. That the mark uses the adjective form of Himalaya does not detract from its geographic significance because the public will continue to perceive the mark as referring to a specific geographic location.

7. Like its prior application for the mark "HIMALAYAN GOJI", the current application for "FREELIFE HIMALAYAN GOJI" should be rejected because (a) "GOJI" is a descriptive word and (b) "HIMALAYAN" describes the geographic origin of Applicant's goods and/or services. On or around June 5, 2003, Applicant filed a separate trademark application for the mark "HIMALAYAN GOJI" (Serial No. 78/975363). In an office action dated December 12, 2003, the United States Patent and Trademark Office ("USPTO") determined that the mark "HIMALAYAN GOJI" is merely descriptive as well as primarily geographically descriptive. In a second office action dated July 12, 2004, the USPTO issued a final refusal pursuant to 15 U.S.C. § 1052(e)(1) because "HIMALAYAN GOJI" describes an ingredient of Applicant's goods and is geographically descriptive. As the USPTO correctly stated, "The bare use of the ingredient word will not be registrable, not even when teamed with a geographically descriptive term." Here, as in its previous application, Applicant attempts to register a mark that contains two unregistrable words — HIMALAYAN GOJI.

8. Additionally, Applicant previously submitted a registration for the mark "HIMLAYAN GOJI JUICE" (Serial No. 78/401240). In an office action dated November 8, 2004, the USPTO found the mark to be unregistrable because it is merely descriptive. Subsequently, Applicant added the following disclaimer to its application: "No claim is made to the exclusive right to use 'HIMLAYAN GOJI JUICE', apart from the mark as shown." Applicant had no choice but to add the disclaimer to register its mark in light of the determination by the USPTO that "HIMALAYAN GOJI JUICE" is unregistrable.

9. The mark "FREELIFE HIMALAYAN GOJI", which contains unregistrable descriptive terms, cannot be saved with the addition of the word "FREELIFE." The application is for a mark that contains both the merely descriptive ingredient word ("GOJI") and the primarily geographically descriptive term

("HIMALAYAN"). As discussed above, the USPTO has rejected applications for nearly identical marks. It is important to note that the addition of a third word to the mark "HIMALAYAN GOJI" does not render it registrable. In an office action dated for November 8, 2004 for the Serial No. 78/401240, the USPTO refused to register the mark "HIMALAYAN GOJI JUICE" because the terms "HIMALAYAN" and "GOJI" are unregistrable. Here, the addition of the term "FREELIFE" does not validate the application for an otherwise unregistrable mark.

10. Applicant's efforts to enforce its marks establish that, if the Application is granted, Applicant will enforce the trademark to impermissibly limit or stifle competition. Applicant and Opposer both offer products containing the same main ingredient (Goji berries). In cease and desist letters dated August 8, 2006 and August 31, 2006, Applicant asserted that Opposer's use of the fanciful mark "HIMALANIA" infringes its marks, including the mark "FREELIFE HIMALAYAN GOJI". Applicant is asserting rights in the word "HIMALAYA" and "GOJI" beyond what the USPTO anticipated when (a) it allowed the mark "HIMALAYAN GOJI" to be added to the Supplemental Registry and (b) allowed the mark "HIMALAYAN GOJI JUICE" to be added to the Principal Registry in light of Applicant's disclaimer that "No claim is made to the exclusive right to use 'HIMALAYAN GOJI JUICE' apart from the mark as shown." Applicable law and regulations limit the use of descriptive terms to ensure that consumers receive full and accurate information of products sold in the marketplace. Consistent with this principle, the USPTO rejected applications for the marks "HIMALAYAN GOJI" and "HIMALAYAN GOJI JUICE" because, without the descriptive words "Himalayan" and "Goji", companies that sell products containing or made with Himalayan Goji berries could not describe their products or the ingredients. Despite its disclaimer, Applicant now seeks to "block" Opposer's participation in the market by asserting trademark rights that not only limit its ability to describe fully its products, but in ways that the USPTO specifically precluded by rejecting two prior applications.

11. Applicant's "FREELIFE HIMALAYAN GOJI" mark for International Class 32 should be denied and this Notice of Opposition should be sustained because: (a) the word "GOJI" is merely descriptive and the term "HIMALAYAN" is primarily

geographically descriptive; (b) the goods that Applicant offers in connection with the mark "FREELIFE HIMALAYAN GOJI" consists of the same main ingredient as Opposer's goods; and (c) Applicant cannot assert rights in a unregistrable mark against its competitors.

WHEREFORE, Opposer prays that the registration sought by Applicant be refused and that this Notice of Opposition be sustained.

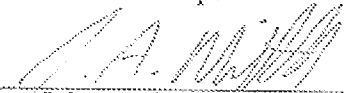
Opposer has appointed the law firm of Arai Mitchell pc, and John Arai Mitchell, as its attorney to sign this Notice of Opposition pursuant to C.F.R. 2.101(b) (37 U.S.C. § 2.101(b)), to prosecute this Notice of Opposition and to transact all business in the United States Patent and Trademark Office in connection therewith.

Please address all communications to John Arai Mitchell, Esq., Arai Mitchell pc, 453 South Spring Street, Suite 930, Los Angeles, California 90013.

Dated: 24 November 2006

Respectfully submitted,

ARAI MITCHELL pc

By: 
John Arai Mitchell

Attorney for Opposer
BRANDSTORM INC.